

REMARKS

Summary of Office Action

Claims 1-34 were pending in this application.

Claims 1-16 and 18-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Abrams U.S. Patent No. 5,653,844 (hereinafter "Abrams").

Claims 17, 33 and 34 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Abrams.

Claims 3 and 26 were rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of Applicant's Response

Applicant has amended claims 1, 3, 23, 29 and 30, in order to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Additionally, applicant has amended claim 26 to respond to the Examiner's assertion that the claim lacked proper antecedent basis. Claim 11, was rewritten in independent form including all of the limitations of the base claim

Express Mail No.: EV270263260US
(i.e., claim 1 before any amendment). Claim 34 was amended to correct a typographical error in order to clearly specify the proper antecedent basis. Claims 35-39 were added in order to more particularly point out and distinctly claim the subject matter which applicant regards as the invention. No new matter has been added by these amendments or new claims.

The rejections are respectfully traversed.

Reconsideration of this application in light of the following remarks is respectfully requested.

Applicant's Response to the
Rejection under 35 U.S.C. § 102(b)

Claims 1-16 and 18-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Abrams. Applicant respectfully traverses this rejection.

Abrams is directed towards "double-sided printing, in effect, on opposite or both surfaces of a layer on a multi-layered foil laminate" (Abrams Abstract). Abrams shows a plastic layer with indicia bonded to another layer or layers, such as a metallic layer (Abrams, col. 2, lines 15-21).

Unlike Abrams, applicant's claimed invention relates to labels comprising indicium and a substrate. The indicium is comprised of at least two different emissivity values that are configured to encode the indicium with

Express Mail No.: EV270263260US
information (see applicant's independent claims as amended).

Emissivity, with regard to applicant's claimed invention, "is the ability of a given surface to emit radiant energy compared to that of a black body at the same temperature and with the same area" (specification, page 3, lines 2-5).

Applicant respectfully submits that neither Abrams nor any prior art of record, shows or suggests a label comprising an indicium on a substrate, in which the indicium is comprised of at least two different emissivity values that are configured to encode information. Abrams does not even reference or include the word emissivity or other equivalent term. The label claimed in each of applicant's independent claims 1, 23, 26, 29 and 30 contains such features.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (*Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d, 1051, 1053). Abrams does not show, either expressly or inherently, a label having varying emissivity values as set forth in applicant's independent claims (see M.P.E.P § 2131).

For at least the above reasons, applicant's invention as set forth in amended claims 1, 23, 26, 29 and 30 is not anticipated or made obvious by Abrams (or any

Express Mail No.: EV270263260US
other prior art of record). Moreover, claims 2-16, 18-22,
24, 25, 27 and 28 all depend from one of the above-
identified independent claims. Therefore, each of those
dependent claims are patentable over the prior art as well.
Applicant respectfully requests that the rejection of
claims 1-16 and 18-32 be withdrawn.

Applicant's Response to the
Rejection under 35 U.S.C. § 103(a)

Claims 17, 33 and 34 were rejected under
35 U.S.C. § 103(a) as being obvious in view of Abrams.
Applicant respectfully traverses the rejection under
35 U.S.C. § 103(a) for the reasons stated in the above
discussion with regards to the rejections under
35 U.S.C. § 102(b).

For at least the above reasons and because
claims 17, 33 and 34 depend from one of independent claims 1
and 30, applicant's claimed invention is not obvious in view
of Abrams. Applicant therefore respectfully requests that
the rejection of claims 17, 33 and 34 be withdrawn.

Applicant's Response to the
Rejection under 35 U.S.C. § 112

Applicant has amended claims 3 and 29 to clarify
that when the "substrate is derived from a portion of said
product" simply means that the "substrate is part of said
product" (applicant's claims 3 and 29). Support for this

Express Mail No.: EV270263260US
amendment may be found in paragraph 12 of applicant's
specification on page 5, lines 12-14.

Applicant has also amended claim 26 to avoid lack
of proper antecedent basis.

Claims 3, 26 and 29 are, therefore, in condition
for allowance.

Applicant's Response to the
Allowable Subject Matter

Per the Examiner's suggestion, applicant has
amended claim 11 to include all of the limitations of the
base claim and any intervening claims as the claims were
originally presented to the Examiner. Claim 11 is therefore
in condition for allowance.

Applicant's Response to the
Informality Objections

Applicant has amended claims 1 and 8 per the
Examiner's recommendation to avoid a lack of proper
antecedent and correct a minor grammatical error. Claims 2
and 8 are, therefore, in condition for allowance.

Applicant's Statement Regarding
New claims 35-39

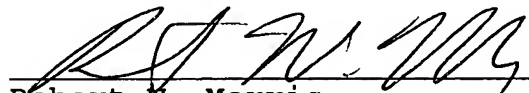
Applicant has added new claims 35-39 to more
particularly point out and distinctly claim the subject
matter applicant regards as the invention. Claim 35
contains the same innovative features as independent

Express Mail No.: EV270263260US
claims 1, 23, 26, 29 and 30. Accordingly, for at least the
above reasons, claim 35 is in condition for allowance.
Claims 36-39 depend on claim 35 and are, therefore, also in
condition for allowance.

Conclusion

For at least the reasons set forth above,
applicant respectfully submits that this application, as
amended, is in condition for allowance. Reconsideration and
a favorable action are respectfully requested.

Respectfully submitted,



Robert W. Morris
Registration No. 36,613
Attorney for Applicant

FISH & NEAVE LLP
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000